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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,046	10/01/2003	Courtney Konopka	81053 7114	6653
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FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			CHANKONG, DOHM	
			ART UNIT	PAPER NUMBER
			2152	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/678,046	Applicant(s) KONOPKA ET AL.	
	Examiner Dohm Chankong	Art Unit 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1> This action is in response to Applicant's amendment and remarks, filed 12.14.05.

Claim 20 has been cancelled. Claim 21 has been added. Claims 1, 4, 12 and 16 have been amended. Claims 1-19 and 21 are presented for further examination.

2> This is a final rejection.

Response to Arguments

3> Applicant's arguments with respect to claims 1-19 and 21 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendment of the claims. Specifically, the claims now include additional limitations directed towards the operation of the diagnostic controller that was neither suggested or claimed by previous iteration of the claims. Since the amendments are introduced to all independent claims, the scope of all claims are altered and a new search of the prior art is proper.

4> In regards to the prior art references, Applicant asserts: "...Wing requires download of client application at least after client registration" [Applicant's remarks, page 7, section 1]. This assertion is contradicted by Wing's disclosure: "The operation may be an operation that can be carried out using a software application already installed on the client computer 108 in which case the script 424 simply activates that application" [0089].

It should be further noted that the new amendments are directed to rather well known functionality of determining whether a controller is located on a computer, and subsequently

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downloading the controller if the controller is not located on the computer. Wing discloses that a user may download the diagnostic controller [Figure 18] and subscribe for a full year to the diagnostic service [Figure 20].

Applicant's amendment attempts to distinguish the claimed invention over Wing's invention, but in doing so, implies that Wing's diagnostic controller needs to be downloaded by a year-long subscribing user every time he wishes to diagnose his computer. Such an implication is unreasonable to one of ordinary skill in the art. A more plausible and reasonable interpretation of Wing's reference is that the diagnostic controller remains on a year-long subscriber's computer after it has been downloaded. This functionality is expressly disclosed by Wing, as discussed above. A determination of whether or not the controller exists on the user computer is thus implied by Wing's disclosure.

See the following 35 U.S.C § 103(a) rejections.

5> Applicant traverses the Official Notice taken with respect to claims 3 and 18. It should be noted that "to adequately traverse [an Official Notice], an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art" [emphasis added]. *MPEP* § 2144.03(c).

Here, Applicant merely asserts, without explanation, that encryption and decryption of scripts is not well known in the art. It should be noted that what is well known in the art is encryption and decryption of any data being passed through a network between a client and server; scripts comprise a subset of such network data.

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However, to further expedite the application's prosecution, the Office supplies documentary evidence in the instant Office Action to support the rejection. See the following 35 U.S.C § 103(a) rejections for claims 3 and 18.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6> Claims 1, 2, 4-8, 16, 17, 19 and 21 are rejected under 35 U.S.C § 103(a) as being unpatentable over Wing et al, U.S Patent Publication No. 2004|0236843 ["Wing"], in view of Balasubramaniam et al, U.S Patent No. 6,701,441 ["Balasubramaniam"].

7> As to claim 1, Wing discloses a method for use in remotely diagnosing an electronic device, comprising:

initiating a diagnostic analysis of an electronic device [0081, 0083, 0084, 0087, 0101];

identifying the electronic device [0080, 0081, 0101, 0103, 0155];

receiving a plurality of scripts for diagnosing the electronic device communicated over a distributed network [0081, 0082, 0085, 0089, 0098, 0158 : Wing discloses several different embodiments of this limitation including a web page with a plurality of scripts or

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“one or more test modules or diagnostic tools...the diagnostic tools may themselves comprise one or more scripts”];

remotely initiating a first diagnostic instruction with at least one of the plurality of scripts [0007, 0012, 103, claims 49 and 57 where : the first instruction involves detecting if the detected devices are operating properly];

receiving a response based on the first diagnostic instruction [0108, 0111];

determining a second diagnostic instruction based on the response with at least one of the plurality of scripts [0082, 0111, 0147, 0158]; and

remotely initiating the second diagnostic instruction with at least one of the plurality of scripts [0007, 0012, claims 49 and 57, 0098, 0158 where: the second instruction involves collecting the performance data of the properly operating detected devices].

Wing does not expressly disclose determining whether the electronic device comprises a diagnostic controller and remotely receiving a diagnostic controller over the distributed network when the electronic device does not comprise a diagnostic controller.

8> However, Wing's discloses: “The operation may be an operation that can be carried out using a software application already installed on the client computer 108 in which case the script 424 simply activates that application” [0089]. Not only is the functionality of determining whether a program [such as a diagnostic controller] is already present on a computer before downloading, it is suggested by Wing's disclosure.

Furthermore, Balasubramaniam discloses determining whether the electronic device

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comprises an application and remotely receiving a diagnostic controller over the distributed network when the electronic device does not comprise an application [Figure 4-1 «items 408, 414» | column 11 «lines 8-31»]. It would have been obvious to one of ordinary skill in the art to incorporate the functionality of determining whether or not software is located on a computer before downloading it into Wing as taught by Balasubramaniam.

Wing discloses downloading a diagnostic controller once after a user has completed registration; it would have been obvious to one of ordinary skill in the art, based on Balasubramaniam's teachings, to modify Wing such that the controller would only need to be downloaded once to the user's computer. Thus, the year-long subscribing user would not need to continuously download the same controller to run the diagnostic scripts every time he chooses to diagnose his computer.

9> As to claims 2 and 17, Wing does not explicitly disclose receiving a web page having the plurality of scripts.

10> Balasubramaniam is directed towards providing computer programs to a user computer, one such program capable of evaluating the user's computer over a computer network [abstract | column 11 «lines 46-47»]. One way that Balasubramaniam achieves this functionality is through the use of ActiveX technology and scripts [column 5 «lines 36-44» | column 9 «lines 4-8»]. Balasubramaniam discloses it is well known in the art to receive at least one web page having a plurality of scripts [column 9 «lines 36-54»]. It would have been obvious to one of ordinary skill in the art to incorporate Johnson's web page script

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functionality into Wing's remote diagnostic systems to enable users to easily select the appropriate script that needs to be run on his computer. One would have been further motivated to provide Balasubramaniam's use of ActiveX technology to enhance functionality already suggested and present within Wing's system [0011, 0079, 0216]. ActiveX technology is an improvement over Wing, enabling scripts and controls to be directly embedded into HTML pages which reduces the need for additional downloading.

11> As to claim 4, Wing discloses remotely receiving a diagnostic controller over the distributed network prior to the identifying the electronic device [0009 : "client application"].

12> As to claim 5, Wing discloses electronically accessing the electronic device and receiving an identity of the electronic device from the electronic device [0085, 0087, 0101 where Wing discloses the client computer is characterized by the user, monitor, ports and other hardware of the client computer. This analysis of the client computer's inventory comprise the "identity" of the computer within Wing's system].

13> As to claim 6, Wing discloses determining if an identity of the electronic device can be directly determined [0101]; and

requesting the identity of the electronic device from a user when the identity cannot be directly determined [0102, 0105].

14> As to claim 7, Wing discloses :

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receiving from over the distributed network an initiation for the diagnosis of the electronic device [0009];

receiving from over the distributed network the identification of the electronic device [0101, 0102];

determining a plurality of scripts to implement the diagnosis of the electronic device [0103 where : the diagnostics tools runs scripts based on the devices determined by Wing's inventory module]; and

communicating the plurality of scripts over the distributed network [0082, 0103 where : Wing's diagnostic tools comprises one or more scripts].

15> As claim 8 does not limit or further define over the previously claimed limitations, it is rejected for at least the same reasons stated above for claim 2 [Balasubramaniam's embedding scripts into an HTML page is analogous to Applicant's use of "incorporating" scripts into a page].

16> As to claim 16, as it does not teach or further define over the previously claimed limitations, it is rejected for at least the same reasons set forth above for claim 1.

17> As to claim 19, Wing discloses at least one of the plurality of scripts initiates a download over the distributed network to the electronic device [0106, 0148].

18> As to claim 21, Wing does not expressly disclose the limitations as claimed.

19> Balasubramaniam discloses:

receiving at least one web page wherein the diagnostic controller is incorporated into the at least one web page [column 9 «lines 36-40»: “ActiveX controls” correspond to diagnostic controller];

extracting the diagnostic controller from the at least one web page [column 9 «lines 36-40» | column 11 «lines 10-31»]; and

initializing the diagnostic controller [column 11 «lines 10-31»].

It would have been obvious to one of ordinary skill in the art to modify Wing’s script delivery system to include the ActiveX functionality discussed above provided by Balasubramaniam. One would have been motivated to provide such a combination as Balasubramaniam’s system would improve Wing’s delivery system, enabling users to easily download programs to their computer [see Balasubramaniam, column 12 «lines 19-28»].

20> Claim 3 and 18 are rejected under 35 U.S.C § 103(a) as being unpatentable over Wing and Balasubramaniam, in further view of Korn, U.S Patent No. 6,880,083.

21> As to claims 3 and 18, Wing does not explicitly disclose decrypting at least a portion of the plurality of the scripts prior to the initiating the first diagnostic instruction. However, it should be noted that principles of cryptography for network data, and specifically the encryption and decryption of data, is well known and expected in the art for providing secure communications over an insecure medium. As such, the step of decrypting an encrypted

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communications between network devices does not constitute a patentable or inventive step over what is well known in the art.

Scripts passed between a server and client correspond to data or information that is encrypted when transmitted through the network. Korn discloses decrypting at least a portion of the plurality of scripts prior to the initiating the script [abstract | column 2 «lines 4-38»]. It would have been obvious to one of ordinary skill in the art to incorporate Korn's secure scripts into Wing. One would have been motivated to provide such a combination to prevent malicious attacks from hackers and internet viruses [see Korn, column 1 «lines 50-52»].

22> Claims 9-15 are rejected under 35 U.S.C § 103(a) as being unpatentable over Wing and Balasubramaniam, in further view of Sewell et al, U.S Patent Publication No. 2002/0165952 [“Sewell”].

23> As to claim 9, Wing does not expressly disclose generating the plurality of scripts for diagnosing the electronic device based on an identity of the electronic device.

24> Sewell is directed towards a system for remote management of network devices through a central repository of diagnostic scripts. Sewell discloses generating a plurality of scripts for diagnosing electronic devices based on an identity of the electronic device [0065, 0066]. It would have been obvious to one of ordinary skill in the art to incorporate Sewell's script generation functionality into Wing's remote diagnostics systems to enable

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customization of scripts based on received diagnostic data. Such an implementation would provide a distinct improvement to Wing's system that currently collects diagnostic data in a database [0074] as well as using scripts to test detected devices [0103] but does not disclose generating specific scripts based on them. Sewell provides such a teaching.

25> As to claim 10, Wing discloses the plurality of scripts provide polling of the electronic device [0103].

26> As to claim 11, Wing discloses the plurality of scripts initiating remote maintenance of the electronic device [0103, 0104, 0106].

27> As to claim 12, Wing and Balasubramaniam disclose a system for remotely diagnosing electronic devices, comprising:

a remote diagnostic controller coupled with the distributed network and with an electronic device to be diagnosed, wherein the diagnostic controller is configured to receive at least one script and implement the at least one script such that the remote diagnostic controller forwards a first instruction to the electronic device to be performed by the electronic device, the remote diagnostic controller is further configured to receive a first reply from the electronic device and to forward a second and/or subsequent instructions to the electronic device based on the first reply and/or previous replies [0009, 0081, 0083, 0085, 0089] where : Wing discloses a client application that is enabled to execute scripts. The scripts can send instructions to trigger execution of program code already resident in the client

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computer. Scripts are received and executed based on the results of previously executed scripts].

Balasubramaniam discloses the diagnostic controller transmitted across the distributed network when a determination whether the electronic device includes a diagnostic controller indicates that the electronic device does not include a diagnostic controller [Figure 4-1 «items 408, 414» | column 11 «lines 8-31»] [see claim 1 rejection above for combination motivation].

Wing and Balasubramaniam do not disclose a script generator.

28> Sewell discloses a script generator coupled with a distributed network, wherein the script generator is configured to compile at least one script and forward that at least one script over the distributed network [0064, 0065, 0066]. It would have been obvious to one of ordinary skill in the art to incorporate Sewell's script generation functionality into Wing's remote diagnostics systems to enable customization of scripts based on received diagnostic data. Such an implementation would provide a distinct improvement to Wing's system that currently collects diagnostic data in a database [0074] as well as using scripts to test detected devices [0103] but does not disclose generating specific scripts based on them. Sewell provides such a teaching.

29> As to claim 13, Wing discloses the diagnostic controller maintained within a host computer, wherein the host computer provides processing capabilities for the diagnostic controller in determining the second instruction [abstract | 0009, 0078, 0083 where : Wing

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discloses downloading of the client application to the client computer, the client application responsible for providing processing of the scripts and takes part, with the server application, in determining the second instruction].

30> As to claim 14, Wing discloses the diagnostic controller maintained within the electronic device, wherein the electronic device provides processing capabilities for the diagnostic controller in determining the second instruction [0075, 0089].

31> As to claim 15, Wing and Balasubramaniam do disclose incorporating at least one script within a web page, and the web page is forwarded over the distributed network [see claim 2 rejection above] but do not disclose a script generator.

32> Sewell discloses a script generator that incorporates the script within a page. As mentioned in the previous claim rejections, it would have been obvious to one of ordinary skill in the art to incorporate Sewell's script generation functionality into Wing's remote diagnostics systems to enable customization of scripts based on received diagnostic data. Such an implementation would provide a distinct improvement to Wing's system that currently collects diagnostic data in a database [0074] as well as using scripts to test detected devices [0103] but does not disclose generating specific scripts based on them. Sewell provides such a teaching.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Thursday [7:00 AM to 5:00 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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DC



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